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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,996	02/12/2002	Chang-Ping Lee	2222.5390005	7160

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

REVAK, CHRISTOPHER A

ART UNIT	PAPER NUMBER
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2431

MAIL DATE	DELIVERY MODE
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02/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/074,996	Applicant(s) LEE ET AL.	
	Examiner Christopher A. Revak	Art Unit 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-18,20-36 and 38-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11-14, 16-18, 31-36, 38-50, 52, 55 and 56 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,20-28,53 and 54 is/are rejected.
- 7) ☒ Claim(s) 9,10,29 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/26/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 20, 2008 has been entered.

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on January 26, 2009 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

3. Applicant's arguments filed with respect to the claims have been fully considered and are persuasive, the previous ground of rejection have been withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 contains the trademark/trade name Microsoft Office and Microsoft Windows. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe software products and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 1,2,4-8,20-28,53, and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Komuro et al, U.S. Patent 6,223,285.

As per claims 1 and 24, It is taught of a computer implemented method and computer program product for securing a method comprising determining whether the file stored in a file system and being accessed is secured; if the file is determined to be secured, activating a cipher module and loading the file from the file system through the cipher module into the an application; and if the file is determined to be non-secured, loading the file from the file system into the application without activating the cipher module (col. 11, lines 23-45).

As per claim 2, it is disclosed that the cipher module, once activated, operates within the operating system (col. 11, lines 23-45).

As per claims 4 and 25, it is taught that the secured file includes a header and an encrypted portion, the header including or pointing to security information including a file key used to decrypt the encrypted portion (col. 11, lines 23-25).

As per claims 5 and 26, it is disclosed of determining of whether the file stored in the file system and being accessed is secured comprises determining if the file stored in the file system being accessed includes the header (col. 11, lines 23-25).

As per claim 6, it is taught that the header further includes a flag indicating that the file stored in the file system and being accessed is secured, and wherein the determining of whether the file stored in the file system and being accessed is secured comprises determining if the file has the flag (col. 11, lines 23-25).

As per claims 7 and 27, it is disclosed wherein the loading the file from the file system through the cipher module into the application comprises retrieving the file key, decrypting the encrypted portion with the file key in the cipher module, and sending the file in clear mode to the application (col. 11, lines 23-45).

As per claims 8 and 28, it is taught that the security information including the file key is encrypted with a user key, and wherein the retrieving of the file key comprises obtaining a user key associated with a user requesting an access to the file, and decrypting the security information with the user key to retrieve the file key (col. 11, lines 23-45).

As per claim 20, it is disclosed of a computer implemented method for providing access control to a the method comprising forwarding a request to access the file to a file system manager in an operating system; activating a document securing module by the file system manager to determine whether the file stored in a file system driver and being accessed is secured; activating a cipher module if the file is determined to be secured; and loading the file from the file system driver through the cipher module into an application (col. 10, lines 15-34 and col. 11, lines 23-45).

As per claim 21, it is taught of retrieving security information from the file when the file is determined to be secured, the security information including a file key and access rules, and obtaining an access privilege of a user requesting to access the file (col. 11, lines 23-25).

As per claim 22, it is disclosed wherein the activating of the cipher module proceeds successfully when the access privilege is within permissions granted by the access rules (col. 11, lines 23-25).

As per claim 23, it is taught wherein the activating of the cipher module comprises decrypting an encrypted portion of the secured file with the file key (col. 11, lines 23-25).

As per claims 53 and 54, it is disclosed wherein launching of an application under the operating system when the request to access the file is received (col. 11, lines 23-45).

Allowable Subject Matter

8. Claims 11-14,16-18,31-36,38-50,52,55, and 56 are allowed.
9. Claims 9,10,29, and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Thursday, 9:00am-5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher A. Revak/
Primary Examiner, Art Unit 2431